

## **ELECTION**

The Office Action states that restriction to one of the following is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a software configurable tracking system, classified in class 324, subclass 207.15.
- II. Claims 10-15, drawn to a method for electromagnetic tracking, classified in class 324, subclass 207.16.
- III. Claims 16-20, drawn to a configurable electromagnetic tracking system, classified in class 324, subclass 200.

March 31, 2010 Office Action at page 2.

Applicant elects, with traverse, the inventions of Group III, namely claims 16-20.

## **AMENDMENT**

Claims 1-9 are hereby canceled, and new Group III claims 21-27, which depend from independent claim 16 are added.

## **TRAVERSAL**

Applicant traverses the restriction requirement because “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” Manual of Patent Examining Procedure (MPEP) at § 803.

Applicant respectfully submits that the Office Action has not established a *prima facie* serious burden with respect to a **search and examination** of all the claims.

In order to establish a *prima facie* serious burden with respect to a search and examination of all the claims, the MPEP states the following:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.

See MPEP at § 803 (emphasis added). The MPEP further states:

the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

(A) **Separate classification thereof**: This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together**: Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search**: Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or

employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

*See* MPEP at § 808.02 (emphasis in italics and underlining added; all other emphasis in original).

The Office Action does not explain why the claims would be separately classified, as required under prong A. The Office Action indicates that all the claims (1-20) are in class 324 (“ELECTRICITY: MEASURING AND TESTING”), but indicates separate subclasses. Subclass 207.15 (“Inductive”) is indicated for claims 1-9. Subclass 207.16 (“Electrically energized”) is indicated for claims 10-15. Subclass 200 (“MAGNETIC”) is indicated for claims 16-20. The Office Action does not, however, explain why the claims would be separately classified, as required by MPEP §§ 803 and 808.02. Further, given the similarities between the claims, Applicant submits that claims 1-20 should not be separately classified, and that the Office should reconsider such classification.

The Office Action does not show separate status in the art, as required under prong B. To this end, the Office Action does not: (1) show a recognition of separate inventive effort by inventors or (2) cite patents that are evidence of separate status and also of a separate field of search.

The Office Action does not show a different field of search, as required under prong C. To this end, the Office Action does not identify different electronic resources that would be searched, or identify different search queries that would be employed. To the extent different subclasses are identified, for the reasons above, Applicant submits that claims 1-20 should not be separately classified, and that the Office should reconsider such classification.

In other words, Applicant respectfully submits that the Office has not established a *prima facie* serious burden with respect to a search and examination of all the claims.

For at least the reasons discussed above, Applicant respectfully requests reconsideration of the restriction requirement. Indeed, all of the pending claims of the present application should be examined together due to the fact that the Office Action has not established a *prima facie* showing of a serious burden with respect to the search and examination of these claims.

Applicant is aware that if this restriction requirement is made final, it will be necessary to file a Petition if this traversal is to be pursued.

If the Examiner has any questions or Applicant can be of any assistance, the Examiner is invited to contact the undersigned attorney.

While no fee is believed due with respect to this Election, the Commissioner is nevertheless authorized to charge any necessary fees, or credit any overpayment to Deposit Account No. 070845 of GEMS-DI.

Respectfully submitted,

Date: April 22, 2010

/Jonathan M. Rushman/  
Jonathan M. Rushman  
Reg. No. 55,870  
Attorney for Applicant

McAndrews, Held & Malloy, Ltd.  
500 W. Madison Street, 34th Floor  
Chicago, IL 60661  
Telephone: (312) 775-8000  
Facsimile: (312) 775-8100